

REMARKS

This application now contains claims 7, 9-11, 13-16 and 18-35. Claims 1-6, 8, 12 and 17 are cancelled herewith. Claims 7, 10 and 16 are amended herewith and claims 18-35 are now. Claims 8 and 12 are replaced by new claims 18-34 which more explicitly claim the structure and method as shown in Fig. 4 and described on page 15, lines 1-11.

The following discussion is directed to the rejections that remain in the application after the present amendment. The other rejections are moot.

Claim 7 stands rejected under 35 U.S.C. §112, second paragraph. The Examiner indicates that the limitation "sufficient to cut hair" is indefinite, since it does not precisely define the particular temperature reached. Applicants respectfully traverse the rejection.

The measure of whether a claim limitation is set forth in MPEP 2144.02 as follows:

In reviewing a claim for compliance with 35 U.S.C. 112, second paragraph, the examiner must consider the claim as a whole to determine whether the claim apprises one of ordinary skill in the art of its scope and, therefore, serves the notice function required by 35 U.S.C. 112, second paragraph, by providing clear warning to others as to what constitutes infringement of the patent. See, e.g., *Solomon v. Kimberly-Clark Corp.*, 216 F.3d 1372, 1379, 55 USPQ2d 1279, 1283.

...

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The MPEP makes clear, as does the case law, that the measure of compliance with 35 U.S.C. §112, paragraph 2 is whether a person would know if he were infringing the claim or not.

Applicants note that the rejected claim language (as amended) utilizes a functional phrase "heated to a temperature sufficient to cut hair function phrase". In order to know whether the claim is infringed, one need only try it to see if the hair is cut. There is no need to know the temperature of the hair in order to know if the claim is infringed. Applicants consider the amendment to the claim to be a purely cosmetic change with respect to clarity.

Claim 7 also stands rejected under 35 U.S.C. §112, second paragraph in that the term "the portion" has insufficient antecedent basis. This typographical error has been removed.

Claim 9 stands rejected under 35 U.S.C. §112, second paragraph in that the term "the heated element" has insufficient antecedent basis. Claim 7 has been amended to add the antecedent for this term. Applicants submit that this amendment, at least as it is reflected on the scope and patentability of claim 7 is purely cosmetic since the previous term used in claim 7 was not objected to.

Claim 16 stands rejected under 35 U.S.C. §112, second paragraph in that the term "the electrically charged element" has insufficient antecedent basis. Applicants have amended this phrase to read electrostatically charged element. This is clearly a cosmetic change and a person reading the claim would have understood that the electrostatically charged element was being referred to, especially since the claim describes how the element is electrostatic charging of the element.

Claim 10 stands rejected under 35 U.S.C. 102(b) as being anticipated by Vrtaric. Applicants believe that this rejection was based on the previous dependence of claim 10 on claim 5. With the cancellation of claim 5, this rejection is moot.

Claims 7, 8, 10, 11, 13 and 15 stand rejected under 35 U.S.C. 102(b) as being anticipated by Kelman. Applicants respectfully traverse the rejection. Furthermore, applicants submit that the Examiner has not set out a *prima facie* anticipation with respect to at least claim 1 (as amended) and certainly not with respect to claim 10

Claim 7 required, before amendment, that there be "a heat-generating elongate element producing heat sufficient to cut hair." The Examiner has identified this with the "laser apparatus 12 being elongated generating an elongated beam of light 10 to cut hair." It is no clear whether the elongated heated element in the claim is identified as the laser or the beam. In either case, it does not meet the limitations of the claim.

If the elongate element is the laser then it fails the definition of the claim in two ways. First there is no teaching in the reference that the laser is an elongate laser. In general, in a device such as that taught in Kelman, a diode laser would be used, due to its small size, efficiency, suitable power lever and simplicity of its power supply. A person of the art would not even consider using any other type of laser in Kelman. A diode laser could not under any means be considered an

elongate element. Furthermore, the original claim language requires that the element produces heat. Lasers do not produce heat *per se*. Rather they produce electromagnetic energy that heats an object that absorbs it. The laser itself is not very hot, or it would burn out.

If the examiner considers the beam to be the elongate heat producing element, then applicants traverse on the following grounds. First, the beam is not a physical element. Second the beam is not a heat producing element for essentially the same reasons as the diode is not a heat producing element.

The amendments to claim 1 have amended the term to "a heated elongate element heated to a temperature sufficient to cut hair." While this amendment was made primarily to reduce the awkwardness of the previous wording, it avoids Kelman for essentially the same reasons as does the previous wording, namely, the diode is not elongate and is not heated to the temperature functionally described in the claim and the beam is not heated (it is electromagnetic radiation) and is not an element.

Independent claim 11, which was not amended requires cutting hair with a heated elongate element. Neither the diode laser nor the beam meets the requirements of a heated elongate element.

Claim 11 is not *prima facie* anticipated for yet another reason. It contains the limitation of "collecting the hair cuttings from the skin of the user. In Kelman, the hair cuttings are never deposited on the skin of the user. Rather the collection is made entirely inside the housing. Thus, there is no such act taught by Kelman.

New claim 35 has been added to claim this feature in the set of apparatus claims. Claims 18-24 claim structure and acts described in conjunction with Fig. 4 of the application which are not found in any of the prior art references.

Claim 16 stands rejected under 35 U.S.C. §103(a) as being unpatentable over Kelman in view of Pragt. Applicants respectfully traverse the rejection and submit that there is no *prima facie* case of obviousness.

Firstly, applicants note that the Teflon coating on Pragt is on surface 4 which is in contact with the skin. (par 0045). However, despite this, the hair cuttings are not electrostatically attracted to the surface, since the hair falls out between the teeth (par 0047). Without being overly speculative, this might be because of structure of the device or the thickness of the layer.

Thus, Pragt teaches against using a member charged by friction with the skin to attract hair. It would not have been obvious since Pragt not only does not teach it but actually clearly indicates that it does not happen.

In Pragt, not only is a teaching away of the use of friction for causing electrostatic capture of hair, the Teflon coating is in the wrong place for capturing hair. In Pragt, the Teflon coating is at the cutting surface. Were there such capture, then the cutting edge, which is designed to avoid clogging by the cut hair, would immediately become clogged with hair, attracted by the electrostatic capture.

Finally, the actual combination mooted by the examiner does not work. Kelman's hair collection is inside the housing. There is no way that any electrostatic attraction in Kelman can be caused by friction of a member against the skin. It would completely change the operation of the hair collection of Kelman to capture the hair anywhere else.

The rejection of claims 7, 8, 11 and 12 over claim 1 of USSN 11/571,753 under the doctrine of obvious type double patenting is respectfully traversed. Nowhere in either the claims or the disclosure of 11/571,753 are the electro-charging characteristics of the blunt scrapper mentioned. In fact, one would be unlikely to use Teflon as the material, since it is easily scratched and would lose its ability to scrape after being rubbed repeatedly against the face and would probably not make an efficient scrapper in any event. The present claim 7 utilizes an electro-chargable material which rules out a metal edge, an obvious choice for the scrapper of 11/571,753.

In view of the above amendments and remarks, applicant submits that the claims are patentable over the prior art. Allowance of the application is respectfully awaited. Applicant requests a telephone interview before the issuance of a further office action. Applicant will attempt to call the Examiner once this response is assigned to the Examiner. If, however, the Examiner begins to work on the case before applicant reaches the Examiner, applicant respectfully requests that the Examiner call the undersigned at 1 (877) 428-5468.

Please note that this is a direct *toll free* number in the US that is answered in the undersigned's Israel office. Israel is 7 hours ahead of Washington.

Respectfully submitted,
Pinchas SHALEV, et al.



Paul Fenster
Reg. No. 33,877

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Enclosed:
Petition for Extension (1 Month); and
Additional Claim Transmittal.